



REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 13-21 are pending. Claims 13-21 were examined and rejected. Claims 13, 15 and 20 are presently amended. No new matter is added. The amendment to claim 13 finds support throughout the application as filed - including in the figures and associated text. The amendment of claim 15 and 20 merely go to form.

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Claim Objection

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Claim 20 has been amended to handle the matter noted by the Examiner. Her attention in regard to the spelling of the term "valve" is much appreciated. Withdrawal of the rejection is requested.

35 U.S.C. §112, ¶2

Claim 15 has been corrected as to antecedent basis for the "second bag." The Examiner's attention regarding this matter is appreciated. In view of the amendment, withdrawal of the rejection is requested.

35 U.S.C. §102 rejection by Fawcett

As amended, claim 1 is believed to be clearly distinguished over Fawcett. As amended, the claim requires that the layer forming the first and second compartment are all joined together. In the case of the reference, no such situation is presented. Rather, the pouch (proving one compartment 30) is formed by joined sheets as noted by the Examiner. However, the second compartment 22 provided by pack 16 is formed by material that is not joined to the pouch. Accordingly, not all of the layers forming the first and second compartments (22, 30 - as asserted by the examiner) are joined together. Thus, anticipation is avoided, and withdrawal of the rejection requested.

35 U.S.C. §102 rejection by Gleason

Gleason was not applied as a reference against claim 14. Since the limitations of claim 14 are now substantially incorporated into claim 13, anticipation by Gleason is believed to be avoided. Therefore, withdrawal of the rejection is requested.

35 U.S.C. §103 rejection over Fawcett in view of Kelly Jr.

Claims 17 and 18 were rejected over Fawcett in view of Kelly Jr. By virtue of the amendment to claim 13 discussed above, Fawcett is no longer provides an adequate base reference in this case for obviousness. (The rejection no longer meets every limitation of the claims as required of a *prima facie* case of obviousness.)

What is more, Applicant asserts that the one would not apply the teachings of Kelly Jr. to meet the motivation expressed by the Examiner (namely, increasing the systems thermal insulation factor.) In this regard, Applicant has submitted copious remarks in the parent case hereto. These are, likewise, presented in an Appeal Brief submitted in that patent application. Since the comments are equally applicable here, they are repeated below for the sake of the Examiner's convenience.

As per MPEP §2142, at "ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS" it is stated that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The motivation stated by the Examiner for the proposed combination of Fawcett and Kelly Jr. has repeatedly been to "increase the thermal insulating factor" of the base reference. *See*, the Office Action dated December 21, 2001 (paper no. 9); the Office Action dated March 25, 2002 (paper no. 14); and the Office action dated September 30, 2002 (paper no. 21). Such a motivation/suggestion is insufficient. Actually, it is believed incorrect.

Dating back to the Amendment filed January 8, 2002, Appellant has explained how employing the teachings of Kelly Jr. would actually decrease the relative thermal insulation properties. In this regard, Appellant has submitted scientific evidence that still has not been accounted for by the Examiner. To summarize, the "cooling medium" or "cooling fluid" in Kelly Jr. is not provided for insulation. In Kelly Jr., insulating material 40 is the only material provided for this purpose. The cooling fluid is meant to be pre-cooled and to extract heat from objects in connection therewith. A desire to increase the

insulating factor of an item in view of the teaching of Kelly Jr. would only involve increasing insulating properties of foam layer 40 – not by substituting cooling fluid for foam.¹ As pointed out by Appellant in the Amendment under 37 C.F.R. §1.111 filed April 17, 2002, any inclusion of higher thermal conductivity gel/water actually results in a relative loss of thermal insulative properties.

However, even if the Examiner were factually correct in her treatment of physical principles, the expressed motivation is inadequate – even, nonsensical. Increasing the thermal insulative properties of the material of the Fawcett pack 16 would render it highly unsuitable for the active cooling as taught by Appellant in using a medium like water or gel. It is to be understood that there is an inverse or opposite relationship between the insulative properties of a material and that material's ability to conduct heat from and cool down an object it is in contact with. Because of this, where a cooling medium is to be used (as in the present invention), there would be no motivation to increase the thermal insulative properties of the foam-like insulator material of Fawcett (which is already higher/more insulative than the invention's cooling medium) because this would decrease the ability of the substituted cooling medium to effectively chill an adjacent substance.

For either reason put forth above, it is believed that the no proper motivation for the combination proposed by the Examiner has been expressed. Accordingly, Appellant requests that the Board find that no prima facie case for obviousness of claims 1-10 has been presented and remand the application to the Examiner with directions to express an applicable motivation or allow the claims.

Accordingly, to the extent these remarks are applicable here, it is requested that they be considered and that the motivation expressed by the Examiner be withdrawn.

In any case, claims 17 and 18 are believed to be in condition for allowance at least in view of the amendment made to claim 13.

¹ This is sensible in that urethane foam may have a thermal conductivity (defining its insulating properties) of about 0.026 W/(m*K) – whereas liquid water has a thermal conductivity is of about 0.61 W/(m*K). Thermodynamics – An Engineering Approach, Y. Cengel and M. Bolew McGraw-Hill, page 95, 1994. Accordingly, foam is a much better insulator than a water

Secondary Considerations

Applicant submits herewith four exhibits presenting evidence of Secondary Considerations. In view of the Examiner's past treatment of such evidence, the Examiner is reminded on the manner in which such evidence is properly handled. Specifically, Applicant references MPEP § 716.01(B) *Consideration of evidence*. Namely, if secondary evidence submitted by Applicant is insufficient in overcoming a rejection, the Examiner "must specifically explain why the evidence is insufficient." General statements as to inadequacy without an explanation supporting such a finding are insufficient. *Id.* Furthermore, MPEP § 716.01(d) requires that if after evaluating the evidence, the Examiner is not convinced by objective evidence in support of patentability, "the next Office action should include a statement to that effect and identify the reasons." *See also*, MPEP §707.07.

The following exhibits are presented for such complete consideration and treatment:

1) International Trade Show Reception. At the 2000 InterBike trade shown (the largest annual tradeshow in the United States for bicycle and sports-related equipment) as referenced in the enclosed copy of pages from the InterBike Show Daily publication, the product was singled out of hundreds for review in the magazine. Traditionally, this honor is reserved only for the most interesting products presented at the show. As evidenced by the write-up, the reason for highlighting the product as one of interest is for the features of the invention that are claimed. This reception is believed to present evidence of immediate commercial success in the reception of the product.

2) On-line product review by Bicycling Magazine. In regard to this exhibit, the Examiner's attention is drawn to page two of the article where it states that the present invention "is a much better option [than adding ice to a bladder] because it keeps fluids colder longer, won't dilute them as ice melts and doesn't harbor sharp ice fragments (which can penetrate regularly bladders)" This appreciation of the product produced according to the claimed invention is underscored by the "Buy It If" and "Forget It If" sections on page 1. Namely, the article is captioned:

BUY IT IF: You prefer your H2O chilled.

FORGET IT IF: As long as you've got water, you don't care about its temperature.

Considering the 4 out of 5 “sprocket” rating the product received (shown at page 1 under the article Author’s name) and the supporting write-up, it is believed that the present invention meets recognized, long-felt need(s) that were not solved by others. *See* MPEP §716.04. One particular need that is apparent in from the article is the need/desire (for some) in cooling of a hydration pack without the negative consequences to the fluid content or pouch. Another long-felt need apparent from the text of the article is in increasing the duration of time for which the drinkable contents of a hydration pouch stay cool.

3. Mountain Biking Magazine feature. Applicant’s product appears here in a feature entitled, “11 Things We Can’t Live Without.” As one of these “can’t live without” products, the use and benefits of the system as believed to be covered by the claims is discussed. As thus written-up as a stand-out product, it is believed that this publication provides strong evidence for Applicant’s product of 1) its continued commercial success and 2) a solution to a long-felt need that others have failed to effectively address – namely a thirst for cold water when biking during hot days.

4. Mountain Bike Action Magazine Product Summary. Regarding the Mountain Bike Action product summary exhibit provided, it describes Applicant’s system as “a great upgrade for any hardcore summer cyclist.” As such, while this article lacks the flair of the previous exhibit, it is similarly believed to provide evidence of commercial success and that the present invention offers a solution to a long felt need otherwise unmet.

5. Mountain Bike Magazine Feature. In a “Just In” feature highlighting newer products on the market, Applicant’s product was singled-out as something riders were cautioned not to leave home without. (The article is titled “Don’t Leave Home Without It.) What is more, the product was highlighted as something that will “make your ride better.” (The title is captioned “5 things that will make your ride better.”) Both these statements are believed to clearly support commercial success by positive media reception. The second statement is also believed to support Applicant’s assertion of meeting the long-felt need of effectively and conveniently delivering chilled water – especially in mountain biking. This is how the product makes riding better as observed by the magazine.

From any and/or all of these exhibits, it is evident that the introduction the present invention to market is looked upon by the public as offering a worthwhile and innovative solution – meeting recognized need(s) heretofore unmet. Indeed, the noted neutral media sources have each independently touted the benefits of the inventive system and encouraged people to buy the same – contributing to its success. In fact, as of May 2003 each of the three major mountain biking magazines (Mountain Biking, Mountain Bike Action and Mountain Bike magazine) have all run very favorable highlights of Applicant's product. In this regard, the product covered by the claims has gained a measure of critical acclaim sought by other companies in the relevant field. Given the full context of the market and the content of the write-ups, Applicant expects serious/extensive comment and supported reasoning from the Examiner should this Secondary Consideration evidence not be found persuasive. It is asserted that this evidence clearly supports allowance of the claims (to the extent they are not already allowable in view of the remarks above), which action is requested.

Conclusion

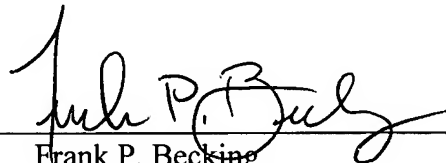
Allowance of the present application is believed in order and therefore requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number SKIL-001CON.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: 4/3/03

By: _____


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